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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

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TECHNOLOGY CENTER 2800
AUG 20 2002

IN RE APPLICATION OF: :
Hideyo OKUSHI, et al : EXAMINER: Doan, Theresa T.
SERIAL NO: 09/731,789 :
FILED: December 8, 2000 : GROUP ART UNIT: 2814
FOR: DIAMOND SEMICONDUCTOR AND DIAMOND SEMICONDUCTOR LIGHT-
EMITTING DEVICE THAT USES THE SEMICONDUCTOR

PROVISIONAL ELECTION

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the Election of Species Requirement dated July 15, 2002, Applicants provisionally elect the species corresponding to Claims 1-6 identified in the Election of Species Requirement. Applicants make this election based on the understanding that Applicants are not prejudiced against filing one or more divisional applications that cover the non-elected claims.

In addition to making this election, Applicants respectfully traverse this Election Requirement for the reason that the different embodiments, indicated in the Election Requirement, have not been shown to be distinct in the manner required by M.P.E.P. §816. MPEP §816 states:

The particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

Since the Election Requirement fails to set forth reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct, it cannot be said to have met the requirement of MPEP §816.

In addition MPEP §806.04(f) requires:

...Claims to be restricted to different species must be mutually exclusive...

The outstanding Official Action fails to address in any way whether the pending claims recite mutually exclusive characteristics. This provides additional basis for traversing the Election of Species Requirement.

Furthermore, MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

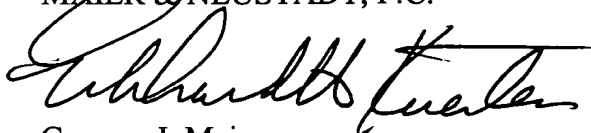
The claims of the present invention would appear to be part of an overlapping search area.

Accordingly, Applicants respectfully traverse the Restriction Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner, whereas it would clearly be burdensome on the Applicants to be required to file, prosecute and maintain separate applications and patents on the identified.

Thus, it is respectfully requested that the requirement to elect a single embodiment be withdrawn, and that a full examination on the merits of Claims 1-10 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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RE: Application Serial No.: 09/731,789

Applicants: Hideyo OKUSHI, et al.

Filing Date: December 8, 2000

For: DIAMOND SEMICONDUCTOR AND DIAMOND
SEMICONDUCTOR LIGHT-EMITTING DEVICE
THAT USES THE SEMICONDUCTOR

Group Art Unit: 2814

Examiner: Doan, Theresa T.

SIR:

Attached hereto for filing are the following papers:

PROVISIONAL ELECTION

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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